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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,787	12/26/2001	Renato Caretta	07040.0113	5883

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EXAMINER

VARGOT, MATHIEU D

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/025,787		CARETTA, RENATO	
	Examiner		Art Unit	
	Mathieu D. Vargot		1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 34-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 34-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/26/01 & 1/18/02</u> . | 6) <input type="checkbox"/> Other: _____ |

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 34-37, 45-52 and 60-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Clinefelter et al.

The applied reference discloses the instant method and apparatus for molding tires using a toroidal support on which an inner liner and tire are built-up, the support is inserted into a mold such that a holding space is formed into which the radially outer portion of the tire can expand by operation of the pressing means comprising the instant channels on the support and wherein the closing of the mold compresses side portions of the tire without touching the outer portions. See Figure 2, which clearly shows this and shows the holding space having radially inner portions which substantially correspond to the size of the side portions of the tire and a radially outer portion which has radial dimensions greater than those of the radially outer portion of the tire. The assembled mold, toroidal support and tire are placed within a vulcanizer for heat curing while fluid is administered through the support channels to press the outer portion of the tire against the mold during vulcanization—see Fig. 3. See also the entire document concerning the process, in particular page 1, lines 97-112 and page 2, lines 19-20.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 1732

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38-44, 53-59 and 63-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clinefelter et al.

Clinefelter et al discloses the basic claimed method and apparatus as set forth in paragraph 1, supra, the reference essentially lacking the preshaping of the tire, the means and steps to circulate the pressure fluid within the holding space and the withdrawing of the pressure fluid concurrently with the introduction thereof. It is submitted that these aspects would have been well within the skill level of the art and obvious modifications to the delivery system shown in Clinefelter et al to facilitate forming the tire and shaping of the tire during vulcanization. While the applied reference uses a pressure fluid for the shaping and a vulcanizer to provide the heating, using steam to perform both the expansion and the heating of a tire is certainly well known and would have been an obvious modification to the process and apparatus of Clinefelter et al to streamline the vulcanization. Ie, instead of requiring two distinct steps and/or fluids, the use of steam would require only one and that is why steam vulcanization is preferably used over air or water expansion carried out concurrently with an external heating as disclosed in the applied reference. The guide duct and filling structure set forth in instant claims 53-58 would have been an obvious modification to the conduit (5) and inner space delivery means as shown in Clinefelter et al as a convenient and effective means to facilitate delivery of the fluid to the channels of the toroidal support. Clinefelter et al does not disclose the material from which the toroidal support is made. However, it is submitted that one of ordinary skill in the art

Art Unit: 1732

would have found it obvious to have made the support out of an elastically yielding material as set forth in claims 65 and 66 so there would be a certain amount of "give" during the molding process between the mold and the support, thereby facilitating molding and release of the tires.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 34-37, 39, 43-54 and 61-66 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,332,999. Although the conflicting claims are not identical, they are not patentably distinct from each other because the previously issued US Patent –999 and the instant claims set forth a method and apparatus which are very similar to each other and both require the inner circumferential portions of the tire to be sealed against the mold while the outer portions of the tire are free to be expanded away from the surface of the toroidal support and against the mold as fluid is conducted through the channels of the support. In essence, the only differences in the claims of USP –999 and those of the instant application reside in terminology used—ie, exactly how the

Art Unit: 1732


limitations are expressed, and the hence the claims are considered to be obvious variants of each other.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni, can be reached on 571 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
March 22, 2004


Mathieu D. Vargot
Primary Examiner
Art Unit 1732

3/22/04